

REMARKS

Claim 1 has been amended in order to delete the R_2 term " $-\text{SO}_2\text{NR}_3\text{R}_4$ ". Applicants, of course, reserve the right to file a continuing application on the same.

Claims 20-26 have been amended in order to delete the phrase "for modulating intestinal motility". Applicants, of course, reserve the right to file a continuing application on the same.

Claims 1-13 were in the application as filed. Claim 13 was cancelled and new claims 14-26 were added in the Preliminary Amendment filed on March 6, 2002. Claims 1-12 and 14-26 remain in the application.

Claims 20-26 are rejected under 35 U.S.C. §112, second paragraph, for the stated reasons that:

Claims 20-26 employed the term "modulating intestinal motility" which encompassed both enhancement of motility or inhibiting motility. Please note that a compound of the claims which has $\beta 3$ -agonistic activity can not be both enhancing *and* inhibiting simultaneously. It is recommended that the particularity be pointed out in accordance with proper descriptive support.

This rejection is believed to be overcome and should be withdrawn in view of the above-described amendments to claims 20-26 in which the phrase "for modulating intestinal motility" has been deleted.

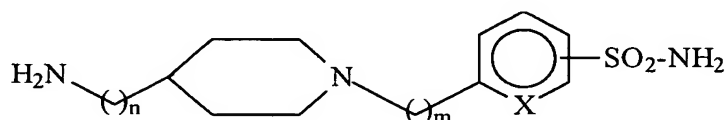
Claims 1, 10-11 and 12-20 are rejected under 35 U.S.C. §102(a), (e) or (g) as being anticipated by Sum et al. In support of this rejection the Examiner has stated that:

Applicants argued that a certified copy of the priority document has been submitted thus obviated the rejection since priority date must be granted.

Initially, applicants are noted that such copy although was submitted by applicants was not found in the file. Further, the certified copy does not warrant granting of priority benefit since no

translation was filed. The granting of priority benefit can only be warranted when an evaluation of the certified translation to confirm that the priority application disclosed the "same" invention as now disclosed in the pending application.

In addition, even if the priority benefit is granted, it can not obviate 102(a), (e) or (f) rejections. Please note that the instant "claims" are drawn the Sum et al. '685 compounds when R₂ is SO₂NR₃R₄. A survey of the specification revealed that descriptive and enabling support of how to make such compounds are not found. Please note that that specification disclosed process on pages 4-9 for making the claimed compounds from an epoxide and a aminopiperidine. No disclosed on how a diamino compound i.e.



can be employed to make the R₂ is SO₂NR₃R₄ compounds (see col. 10-14, Sum '685). Since species anticipates the genus, the Sum '685 patent constitutes 102(a), (e) or (f) for the scope of R₂ is SO₂NR₃R₄.

This rejection is traversed and reconsideration and withdrawal thereof are requested for the reasons given hereinbelow.

As per the Examiner's request, enclosed is a certified English language translation of FR9911204, filed September 8, 1999. In addition, as the Examiner has indicated that the previously submitted certified copy of priority document FR9911204 can not be found in the Patent Office file, applicants are enclosing herewith a copy of said priority document for the Examiner's convenience.

In regard to Sum et al., U.S. Patent No. 6,444,685, applicants would provide the following comments. Initially, it is point out that since applicants have now provided the Examiner with a certified English language translation of French priority document FR9911204, filed September 8, 1999, applicants clearly are entitled to their claim of foreign priority benefit from this application under 35 U.S.C. §119. Thus, as the September 8, 1999 filing date of FR9911204 is prior to even the July 17, 2000 filing date of U.S. Provisional Application No. 60/218,589, from which U.S. Patent No. 6,444,685 claims priority, U.S.

Patent No. 6,444,685 would not be available as a reference under 35 U.S.C. §102(a), 102(e) or 102(g) against the instantly claimed subject matter.

Turning now to the Examiner's assertion that the instant specification does not provide enabling support concerning how to make compounds of the invention wherein R_2 is " $SO_2NR_3R_4$ " applicants would point out that this statement is simply incorrect. In this regard, applicants note that page 4, line 12 to page 6, line 15 of the instant specification (page 2, line 25 to page 4, line 8 of the certified English translation of French priority document FR9911204) clearly describes processes for making various compounds of the invention including those wherein R_2 is $SO_2NR_3R_4$. Accordingly, the instant specification clearly teaches how to make the compounds of the invention wherein R_2 is $SO_2NR_3R_4$ and, therefore, no basis is seen for the Examiner's assertion that such compounds are not enabled. Nevertheless, in an effort to advance the prosecution of the instant application, applicants have deleted the R_2 group $SO_2NR_3R_4$ and thus have obviated the Examiner's basis for the rejection of claims 1, 10-11 and 12-20 under 35 U.S.C. §§ 102(a), (e) or (g).

Claims 1-5, 8, 10-11, 14-17, 20-24 are rejected under 35 U.S.C. 103(a) over Sum et al., U.S. Patent No. 6,444,685 in view of Steffan et al., U.S. 6,506,901. In support of this rejection the Examiner has stated that:

The same reasoning that the lacking of support for the R_2 is $SO_2NR_3R_4$ compounds as delineated supra in section 4 is also applicable here and incorporated by reference.

This rejection is traversed and reconsideration and withdrawal thereof are requested for the reasons given hereinbelow.

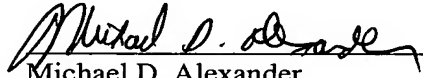
For the reasons set forth hereinabove, Sum et al., U.S. Patent No. 6,444,685 is not available as a reference against the instant application. Furthermore, since applicant's September 8, 1999 foreign priority date is prior to even the July 17, 2000 filing date of U.S. provisional application No. 60/218,753, from which Steffan et al., U.S. Patent No. 6,506,901 claims priority, U.S. Patent No. 6,506,901 would also not be available as a reference against the instant application.

Claim 9 is objected to for being dependent on a rejected base claim. This objection is traversed and reconsideration and withdrawal thereof are requested for the reasons given hereinbelow. As the rejection of claim 1, from which claim 9 depends, is believed to be overcome, the objection to claim 9 is rendered moot and should be withdrawn.

In view of the foregoing amendments and remarks, reconsideration and withdrawal of: (a) the rejection of claims 20-26 and under 35 U.S.C. §112, second paragraph; (b) the rejection of claims 1, 10-11, and 12-20 under 35 U.S.C. §102(a), (e) or (g); (c) the rejection of claims 1-5, 8, 10-11, 14-17 and 20-24 under 35 U.S.C. §103(a); and (d) the objection to claim 9, is requested and the allowance of claims 1-12 and 14-26 is respectfully requested.

Respectfully submitted,

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